

REMARKS

Claims 13-16, 18 and 19 currently are pending in this application. Claim 17 has been cancelled. Applicants respectfully request reconsideration in view of the above amendments and the following remarks.

As a preliminary matter, before responding to the rejections raised by the Examiner, Applicants respectfully submit that the finality of the present rejections is premature. Applicants filed a Request for Continued Examination on February 24, 2005, accompanied by claim amendments and two new claims directed to overcoming the art of record in the final Office Action dated October 6, 2004. Citing MPEP §706.07(b), the Examiner made final the first Office Action after the Request for Continued Examination. The Examiner alleged that the present claims could have been finally rejected on the same art of record if entered in the earlier application.

According to MPEP §706.07(b), however, the claims of a continuing application only may be finally rejected on a first Office Action if: (1) all the claims are drawn to the same invention in the earlier application; and (2) all the claims would have been properly finally rejected on the grounds and art of record if they had been entered in the earlier application.

In the present application, Applicants added two new claims (claims 18 and 19) with the Request for Continued Examination. Independent claim 19 adds a process step, which is directed to different subject matter from the prior claims, i.e., a dehumidification step. Accordingly, claim 19 is not the same invention from that present in the earlier application. As explained in MPEP §706.07(b), it is not proper to make a first Office Action final if new subject matter has been added. Moreover, Applicants respectfully submit that claim 19 would not properly have been finally rejected in the earlier application based on the art of record, as discussed in detail below. In particular, the dehumidification step is, in fact, critical to the inventive process in claim 19 and the Examiner has not identified any prior art that discloses

such step. Therefore, because claim 19 could not have been properly finally rejected in the earlier application on the art of record, the requirements of MPEP §706.07(b) are not satisfied.

Moreover, Applicants also respectfully submit that the new subject matter added to independent claim 13 also could not have been properly finally rejected in the earlier application on the same art, as discussed in detail below. As such, Applicants also submit that the requirements of MPEP §706.07(b) are not satisfied for claim 13, and thus the claims that depend therefrom.

In view of the above remarks, Applicants respectfully request reconsideration and withdrawal of the finality of the rejection.

Applicants' Response To §112, First Paragraph Rejection

Claim 17 stands rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Claim 17 has been cancelled.

Applicants' Response To §103 Rejection over Applicants' Admitted Prior Art in view of Singer

Claims 13, 18 and 19 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Applicants' prior art admission (pages 5-8 of Applicants' present specification) in view of U.S. Patent No. 5,100,683 to Singer et al. (hereinafter "Singer"). Applicants respectfully traverse the rejection on the basis that the cited combination fails to render the claims *prima facie* obvious.

With respect to claim 13, the Examiner acknowledges that Singer does not disclose process steps (a) - (c) recited therein. According to the Examiner, Applicants admitted that such process steps are well known on pages 5-7 of its specification. The Examiner, however, fails to provide any basis for combining Singer with process steps (a) - (c) described in the specification.

As stated in MPEP §2143, there must be some suggestion or motivation to modify a reference or to combine reference teachings to establish a *prima facie* case of obviousness. In addition, there must be a reasonable expectation of success. The Examiner's rejection is devoid of any allegation or explanation of the requisite motivation to modify the process of Singer to include Applicant's additional process steps (a) - (c). It should be noted that "[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure." *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Because such showing is absent, the Examiner's rejection fails to establish a *prima facie* case of obviousness.

Moreover, the requisite motivation to modify Singer to add pre-processing steps (a) - (c), as recited in claim 13, does not exist. Singer discloses coating food products, such as breakfast cereals and snack foods. For example, Singer specifically discloses puffed cheese-flavored items. In contrast, Applicants' present invention is related to coating chewing gum pieces. Coating and preparing chewing gum involves different considerations that do not arise in processing other food products.

In particular, individual chewing gum pieces tend to become sticky when introduced into coating apparatus. As explained in Applicants' specification at pages 16-17, gum material becomes tacky or sticky when heated and can adhere together, which is undesirable. It is desirable, therefore, to take initial steps to prevent the pieces from adhering together. With the method of claim 13, an initial coating on the gum pieces is provided prior to their introduction into the rotating drum member. As recited in steps (a) - (c) of claim 13, a mixer is employed to provide the initial coating on the gum pieces. Applying an initial coating in this manner not only prevents stickiness, but also promotes a smoother and uniform overall coating (Applicants' specification, at pages 18-19). Further, once pre-coated, gum pieces can be processed at much higher temperatures when initially introduced into the rotating drum member. Although important to coating chewing gum products, these concerns with temperature sensitivity may not be relevant for other food products. There is no disclosure in Singer of initial temperature

sensitivity to introduced products. Additional pre-processing steps are not contemplated by Singer. Accordingly, there is no motivation to modify the process of Singer to include additional pre-processing steps.

In view of the above, Applicants respectfully submit that claim 13 is patentable over Applicants' admitted prior art and Singer, each taken alone or in combination.

With respect to claim 18, it is unclear as to the basis of this rejection. Claim 18 depends from claim 13. As depending from an allowable claim for the reasons set forth above, it is respectfully submitted that claim 18 is patentable.

With respect to independent claim 19, the Examiner merely asserts that "[t]he heated air humidity (claim 19, step (d)) is not critical." This statement does not establish a *prima facie* case of obviousness. The dehumidification step in claim 19 is an important feature in processing chewing gum pieces. As discussed above with respect to claim 13, coating chewing gum products involves concerns, particularly stickiness or tackiness, that are not relevant for other food products. Another manner of addressing this problem is to dehumidify the air prior to its introduction into the rotating drum member. (Applicants' specification, at pages 13, 17). In sum, the dehumidification step is critical in claim 19 and must be addressed by the Examiner. Nowhere in Applicants' admitted prior art or in Singer is there disclosure or suggestion to dehumidify heated air "prior to introduction into said drum member". Even taking the Examiner's hypothetical combination of Applicants' admitted prior art and Singer, the resulting structure would not provide dehumidification of heated air. It is respectfully submitted, therefore, that claim 19 is patentable over Applicants' admitted prior art and Singer, each taken alone or in combination.

Applicants' Response to 35 U.S.C. §103 Rejection over Applicant's Admitted Prior Art in view of Singer and Dumas, Greenberg, Yotka or Richey

Claims 14-17 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Applicants' admitted prior art (pages 5-8 of Applicants' present specification) in view of Singer and one of U.S. Patent Nos. 5,900,261 to Ribadeau-Dumas et al (hereinafter "Dumas"), 5,980,955 to Greenberg et al (hereinafter "Greenberg"), 5,952,019 to Yotka et al (hereinafter "Yotka"), or 5,545,417 to Richey et al (hereinafter "Richey"). Applicants respectfully traverse the rejection on the basis that the cited combination fails to render the claims *prima facie* obvious.

Claims 14-17 depend from claim 13. Dumas, Greenberg, Yotka and Richey all fail to cure the deficiencies of Singer and Applicants' admitted prior art noted above. These additional references were cited merely for their teaching of including gum arabic in chewing gum coatings, and contain no disclosure of relevance to Applicants' claim 13. Specifically, nowhere in Dumas, Greenberg, Yotka or Richey is there any disclosure, teaching, or suggestion related to coating chewing gum by using both a mixer and a continuous coating apparatus.

Therefore, claims 14-17 are not obvious in view of the teachings of Applicants' admitted prior art in view of Singer and one of Dumas, Greenberg, Yotka or Richey. Applicants respectfully request reconsideration and withdrawal of the Section 103 rejection based on this combination.

Should the Examiner have any questions or comments concerning the above, the Examiner is respectfully invited to contact the undersigned attorney at the telephone number given below.

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The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 08-2461.

Respectfully submitted,



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